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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/204,390 12/02/98 EVERLING

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EXAMINER

WM02/0226

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NEW YORK NY 10036-8403

PWLI, J

ART UNIT

PAPER NUMBER

2164

DATE MAILED:

02/26/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/204,390

Applicant(s)

EVERLING ET AL.

Examiner

Jeffrey C Pwu

Art Unit

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2000.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

DETAILED ACTION***Claim Rejections - 35 USC § 102***

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

1. Claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by *Lawlor* et al (U.S. Patent No. 5,870,724).

Claim 1:

A method for processing transaction data comprising the steps of:
receiving transaction data, the transaction data containing account numbers (col.29, lines 12-13);

➤identifying non-issuer account numbers which represent accounts not issued by an issuer (col 4, lines 13-16); and

➤matching the identified non-issuer account numbers with account numbers representing account issued by the issuer (col 13, lines 51-54 and figure 1).

Claim 2:

A method wherein the matching steps comprises:

➤identifying a consumer associated with at least one of the identified non-issuer account numbers (figure 10 teaches the users being identified in reference 366)

➤determining if the identified consumer is a customer of the issuer, the customer having an issuer account number representing an issuer account issued by the issuer (figure 10 teaches the system checking to see if the user is a member, reference 368, 370)

➤linking the non-issuer account number of the customer with the issuer account number of the customer (col 35, lines 18-25)

"To use billpaying features, customers provide the service provider in advance with a list of payees (names, account numbers, addresses)", "The authorization module 80D is the means by which the system determines the customer identity (through the PIN and other values transmitted by the terminal).

"User account number and PIN values are transmitted to the user's bank (over the ATM network 66 in the preferred embodiment) for verification. When the authorization module 80D receives verification from the bank the user is cleared for transactions (col. 19, line 63 to col. 20, lines 3)"

Claim 3:

➤maintaining a database containing issuer account numbers representing issuer accounts of customers of an issuer, and containing customer non-issuer account numbers representing non-issuer accounts of the customers (col 13, lines 58-59)

Claim 4:

➤adding the matched non-issuer account numbers to the database as customer non-issuer account numbers (col 20, lines 9-10)

Claim 5:

database further contains historical transaction data representing previous transactions performed by the customer using a non-issuer account, the method further comprising the step of: (col. 7, lines 4-5)

➤updating the historical transaction data in the database by adding received transaction data, which contains matched non-issuer account numbers (col 20, lines 11-15)

Claim 6:

➤performing queries on the database (col 20, lines 15-19)

Claim 7:

➤determining the use of the non-issuer account by the customer in response to a result of the query (col 20, lines 16-19)

Claim 8:

➤marketing services of the issuer to the customer in response to the determined use by the customer (col 6, lines 60-61 and col 13, lines 55-57)

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Lawlor** et al (U.S. Patent No. 5,870,724) in view of **Pascoe** (U.S. Patent No. 5,813,015).

Lawlor discloses the method for processing transaction data. However, Lawlor fails to disclose the "scrubbing" action taken on the transaction files.

Pascoe discloses a method for "scrubbing" a file that eliminates files (col 3, lines 24-34).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Lawlor and Pascoe because "scrubbing" is an effective and common method for eliminating files. "Scrubbing" or filtering files is an old and well-known method in the computer art. It is beneficial to eliminate transaction data, which contains duplicate account numbers because it is redundant and wastes storage space in the system. It is efficient to eliminate transaction data containing account number issued by

the user because the purpose of this system is to look at non-issuer accounts and therefore the issued accounts are an inconvenience and also take up valuable, usable space in the system.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Konya** (U.S. Patent No. 5,937,396) in view of **Pascoe** (U.S. Patent No. 5,813,015).

➤receiving new transaction data, the new transaction data representing new credit transactions and comprising records containing at least account numbers of accounts which initiated the new credit transactions (Konya col 6, lines 9-11, 18-20, col 7, lines 58-61 and col 12, lines 43-44 teaches a database, which can receive new data, containing information on a plurality of banks and customer transaction data)

➤associating by customer, the non-issuer account numbers with issuer account numbers (col. 11, lines 62-65)

However, Konya does not disclose eliminating new transaction data containing issuer account numbers, the issuer account numbers representing issuer accounts of customers of an issuer (Pascoe, col 3, lines 24-34) and generating a list of account numbers contained in the new transaction data which are not issuer account numbers (Pascoe, col 4, lines 29-30). These steps comprise a well-known method in the computer art known as "scrubbing". The "scrubbing" method is shown in claim 9 by Pascoe and is therefore rejected on the same analysis. Konya's method of processing transaction deals with a plurality of financial institutions as does Lawlor and can therefore be combined with Pascoe for the same reasoning.

Claims 11-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Konya** (U.S. Patent No. 5,937,396) in view of **Pascoe** (U.S. Patent No. 5,813,015) as applied to claim 10 above, and further in view of **Lawlor** (U.S. Patent No. 5,870,724).

Claim 11:

This claim comprises the same steps as claim 3 and is therefore rejected on the same analysis.

Claim 12:

This claim comprises the same steps as claim 4 and is therefore rejected on the same analysis.

Claim 13:

This claim comprises the same steps as claim 5 and is therefore rejected on the same analysis.

Claim 14:

This claim comprises the same steps as claim 6 and is therefore rejected on the same analysis.

Claim 15:

This claim comprises the same steps as claim 7 and is therefore rejected on the same analysis.

Claim 16:

This claim comprises the same steps as claim 8 and is therefore rejected on the same analysis.

Claim 17:

This claim comprises the same steps as claim 9 and is therefore rejected on the same analysis.

Claim 18:

This claim comprises the same steps as claims 3, 5, 10, 12 and 17 and is therefore rejected on the same analysis.

Claim 19:

This claim comprises the same steps as claim 6 and is therefore rejected on the same analysis.

Claim 20:

This claim comprises the same steps as claim 7 and is therefore rejected on the same analysis.

Claim 21:

This claim comprises the same steps as claim 8 and is therefore rejected on the same analysis.

Response to Arguments

3. Applicant argues that Lawlor does not "identify non-issuer account numbers that represent accounts that are not issued by an issuer". Examiner points out that ATMs have the same functionality in identifying an account number and an account number of a different bank, which is the non-issuing institution. Applicant's claims are not directed towards an ATM, however they do not exclude ATMs and therefore the rejection remains.

Applicant argues that Lawlor does not teach the "matching of the identified non issuer account numbers with account numbers that represent accounts issued by the issuer". Lawlor clearly identifies that there are both issuer account numbers and non-issuer account numbers in his system.' The inclusion of a database in Lawlor's invention clearly teaches the matching capabilities in applicant's claims and therefore the rejection remains.

Since Lawlor does in fact read on applicant's claim 1, it remains rejected, and therefore dependent claims 2-8 also remain rejected under 35 U.S.C. 102(e) as being anticipated by Lawlor et al (U.S. Patent No. 5,870,724).

Applicant claims that Pascoe does not teach "identification of which data is unnecessary and which data is redundant" and "specifically which type of data to eliminate from the data". However, claim 9 does not state anywhere that the invention needs to identify which data is unnecessary and which data is redundant.

Examiner agrees that Pascoe does not specifically use the words "transaction data" or "account numbers". However, Pascoe does clearly state that it "allows a user to select and specify criteria for "scrubbing" a file or container object". Since Pascoe allows the option to designate which files to "scrub" it is obvious when combined with Lawlor that the criteria that will be chosen can include transaction data such as account numbers.

Since the combination of Pascoe and Lawlor clearly anticipate scrubbing the files to delete the redundant transaction data, claim 9 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Lawlor et al in view of Pascoe.

Applicant argues that for claim 10, Konya does not teach "associating non-issuer account numbers and issuer account numbers". However, Examiner once again refers to the argument for claim 1 by Lawlor. Since Konya discloses that the "main computer includes a database containing entry codes and routing codes for a plurality of banks belonging to the present electronic transfer network" (abstract) it clearly reads on associating account numbers since matching information is inherent in a database.

Examiner refers to the above reasoning for Pascoe's description of scrubbing files, making it relevant to this case. Therefore, the combination of Pascoe and Konya do in fact teach the limitations of claim 10 that include not only associating account numbers but scrubbing the files. Since applicant's claim 10 does not signify that it is not an ATM machine, Konya's invention is applicable because it provides the same functionality with account numbers.

Applicant argues for claim 10 that Pascoe does not teach "identifying account numbers in the list which represent accounts owned by the customers." However, applicant admits that

Pascoe does teach searching methods. When this identification method is combined with Konya's invention involving different accounts, it reads on applicant's claim 10 because searching or identifying methods are clearly a significant aspect of a transaction data system and would help the efficiency of the system.

Since Konya and Pascoe do read on applicant's claim 10, it remains rejected under 35 U.S.C. 103(a) as being unpatentable over Konya in view of Pascoe. Konya and Pascoe, in addition to Lawlor are in the same financial business art and are therefore relevant applicable art.

Claims 11-21 also remain rejected since applicant's arguments for the claims they are dependent upon are moot.

Continued Examination Under 37 CFR 1.114

4. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to

37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Pwu whose telephone number is 308-7835. The examiner can normally be reached on 8-5.

Jeffrey Pwu

February 19, 2001



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